

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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SERIAL NO: 76/182175

SEP 9 2003

APPLICANT: M & N Plastics, Inc.

**CORRESPONDENT ADDRESS:**

THOMAS N YOUNG  
YOUNG & BASILE PC  
3001 WEST BIG BEAVER ROAD SUITE 624  
TROY MI 48084-3197

**RETURN ADDRESS:**

Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3514  
ecom114@uspto.gov

MARK: JOE COOL

CORRESPONDENT'S REFERENCE/DOCKET NO: MNI-100

CORRESPONDENT EMAIL ADDRESS:

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

**EXAMINING ATTORNEY'S APPEAL BRIEF**

The applicant appealed the examining attorney's refusal to register the proposed mark on the Principal Register because the proposed mark is ornamental as used on the goods pursuant to Trademark Act §§1, 2 and 45, 15 U.S.C. §§1051, 1052 and 1127.

**STATEMENT OF FACTS**

The applicant filed an intent-to-use based application on December 8, 2000, seeking registration of the proposed mark JOE COOL on the Principal Register for plastic sleeves that provide thermal protection to users of hot drink cups. The examining attorney subsequently approved the mark for publication. The Office issued a notice of allowance on December 4, 2001. The applicant filed a statement of use on May 28, 2002. The examining attorney refused the applicant's mark at this point because the specimen showed that the mark was being used in an

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ornamental manner. The applicant subsequently disputed the refusal. The examining attorney did not find the applicant's arguments to be persuasive and issued a final refusal. The applicant filed a notice of appeal on May 2, 2003, and its appeal brief on July 2, 2003. The ornamentation refusal is the only issue on appeal.

### ISSUE ON APPEAL

Whether the applicant's proposed mark, JOE COOL, is ornamental as used on the goods.

### ARGUMENT

The applicant's proposed mark, JOE COOL, is an ornamental feature that does not identify and distinguish the applicant's goods. An ornamental feature may include words. TMEP §1203.03. The examining attorney should consider the following factors to determine whether ornamental matter can be registered: (1) the commercial impression of the proposed mark; (2) the relevant practices of the trade; (3) secondary source, if applicable; and (4) evidence of distinctiveness. TMEP §1203.03.

Whether JOE COOL functions as a trademark is a fact question of which the judgment of the examining attorney is entitled to a presumption of correctness. *See In re Tilcon Warren, Inc.*, 221 USPQ 86, 88 (TTAB 1984) and cases cited therein. Accordingly, the burden of proof is on applicant to establish by competent evidence that the mark does serve a trademark function. *Id.*, at 88.

A. Commercial Impression.

The examining attorney must determine whether the overall commercial impression of the proposed mark is that of a trademark. TMEP §1202.03(a). When considering the commercial impression of the mark, the examining attorney should consider the significance of the mark, i.e., whether the mark is a common expression or not, and the size, location and dominance of the proposed mark as applied to the goods. *In re Dimitri's Inc.*, 9 USPQ2d 1666, 1667 (TTAB 1988); *In re Astro-Gods Inc.*, 223 USPQ 621, 623 (TTAB 1984); TMEP §1202.03(a).

The proposed mark JOE COOL is of a common, well known phrase that is not inherently distinctive. As stated in the *Trademark Manual of Examining Procedure*, “[c]ommon expressions and symbols (e.g., the peace symbol, “smiley face,” or the phrase “Have a Nice Day”) are normally not perceived as marks.” TMEP §1202.03(a). The evidence of record shows that the wording JOE COOL is used for a wide variety of goods and services. This common usage for a wide variety of goods and services diminishes the trademark significance of the mark because consumers are constantly bombarded with the use of the wording JOE COOL in a non-trademark manner. In fact, the internationally famous cartoonist Charles Shultz popularized the wording JOE COOL to describe the alternate persona of his SNOOPY the dog character in his PEANUTS comic strip. Consequently, the significance of the wording JOE COOL is diminished by its popularity as a well-known phrase for a comic strip character persona and its significance as a popular culture icon. Thus, JOE COOL is not inherently distinctive.

While there is no prescribed place for affixation of a mark to the goods, the ornamental nature of the applicant's proposed mark is made more obvious by the size, location, and dominance of the proposed mark as applied to the goods. As shown by the specimen, the wording JOE COOL is placed in large stylized letters on the "sides" of the goods.

Usually, a small, neat, and discrete word or design feature is likely to create the commercial impression of a trademark, whereas a larger rendition of the same matter emblazoned across the front of the goods is likely to be perceived merely as a decorative or ornamental feature of the goods.<sup>1</sup> TMEP §1202.03(a). Here, the proposed mark JOE COOL is displayed in large letters on the goods. Moreover, the stylization of the mark on the specimens is of a decorative nature; the wording is in stylized form and the wording COOL is spelled COO!. Furthermore, the applicant could have easily placed the proposed mark in small discrete letters around the rim or lip of the goods. For example, the applicant placed the wording 800 4 JOE COOL in small non-stylized letters across the top of *one* of the sides of the goods; this designation is more likely to be perceived as a source indicator. Instead, the applicant displays the wording JOE COOL in large stylized letters that immediately catches the eye.

Additionally, the applicant did not provide any evidence that such placement is standard in the relevant industry. Otherwise, the applicant would have provided such evidence; such evidence may have changed the consideration of the commercial impression made by the mark. Therefore, one may presume that the placement of the mark on the goods is not the standard in

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<sup>1</sup> The examining attorney acknowledges that this standard has been applied primarily to clothing. However, the rationale inherent in this standard, i.e., that the ornamentation determination is based upon the size, location, and dominance of the mark as applied to the goods, is valid and applicable in the instant case. Moreover, it is the

the industry. Accordingly, one must ask why the applicant would place the non-significant mark in large, stylized letters on both sides of the goods when it had the ability to place the mark in small discrete letters that are more likely to be perceived as trademarks. The only reasonable conclusion is that the applicant placed the mark in large, stylized, letters on the goods to be a decorative feature used to sell the product. In short, the applicant seeks to sell the product based on the "hip" cultural connotation of the well known phrase JOE COOL, not to use the mark as a source indicator. See *Damn I'm Good Inc. v. Sakowitz, Inc.*, 514 F. Supp. 1357, 212 USPQ 684 (S.D.N.Y. 1981) ("DAMN I'M GOOD," inscribed in large letters on bracelets and used on hang tags affixed to the goods, found to be without any source-indicating significance).

Evidence of the applicant's desire to capitalize on the cultural connotation of the well-known wording JOE COOL is provided by the applicant's advertisements. As the advertisement submitted by the applicant states, "Joe is environmentally responsible too!" and "... an entire energy consuming production step is eliminated. Now that's cool."

As shown above, the wording JOE COOL is a common phrase that is not inherently distinctive. Moreover, the size, location, and dominance of the proposed mark as applied to the goods is of an ornamental nature. Thus, one must conclude that consumers would not perceive the wording JOE COOL as a source indicator as applied to the goods. See *Damn I'm Good Inc. v. Sakowitz, Inc.*, 514 F. Supp. 1357, 212 USPQ 684 (S.D.N.Y. 1981); *In re Pro-Line Corp.*, 28 USPQ2d 1141 (TTAB 1993) (BLACKER THE COLLEGE SWEETER THE KNOWLEDGE primarily ornamental slogan that is not likely to be perceived as source indicator); *In re Dimitri's Inc.*,

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experience of the examining attorney that the vast majority of trademarks, regardless of the goods involved, are usually displayed on the goods in wording that is small, neat, and placed discretely on the goods.

9 USPQ2d 1666 (TTAB 1988) ("SUMO," as used in connection with stylized representations of sumo wrestlers on applicant's T-shirts and baseball-style caps); *In re Astro-Gods Inc.*, 223 USPQ 621, 624 (TTAB 1984) ("[T]he designation 'ASTRO GODS' and design is not likely to be perceived as anything other than part of the thematic whole of the ornamentation of applicant's shirts."); *In re Original Red Plate Co.*, 223 USPQ 836 (TTAB 1984) ("YOU ARE SPECIAL TODAY" for ceramic plates found to be without any source-indicating significance).

B. Practices of the Trade.

The examining attorney must consider if the subject matter is unique or unusual in a particular field or whether it is a mere refinement of a commonly adopted and well known form of ornamentation for a particular class of goods that would be viewed by the public as a dress or ornamentation for the goods. TMEP §1202.03(b). There is no evidence of record that shows that the placement of the wording JOE COOL in large stylized letters on the goods is a commonly adopted and well known form of ornamentation for the goods. Nor has the applicant provided any such evidence. Therefore, this factor cannot be considered.

C. Secondary Source.

The applicant may also seek to show that the mark is recognized as a mark through its use with goods or services other than those identified in the application. TMEP §1202.03(c). The applicant did not provide any evidence of secondary source. Therefore, this factor cannot be considered.

D. Acquired Distinctiveness.

The applicant failed to provide any evidence that the inherently "undistinctive" mark has acquired distinctiveness as a source indicator. Thus, the issue of acquired distinctiveness is moot.

As shown above, the wording JOE COOL is not inherently distinctive; the wording is a well known phrase. Moreover, the size, location, and dominance of the mark applied to the goods can only lead to the conclusion that a consumer would perceive the mark as an ornamental feature of the goods; the wording appears in large, decorative, "eye catching" letters and is the dominant wording on the goods. As a result, the applicant's specimen shows only ornamental use of the wording JOE COOL on the goods.

**ANALYSIS OF THE APPLICANT'S ARGUMENTS**

The applicant argues that the examining attorney must consider the "classic characteristics" of true trademarks, which according to the applicant, include the appearance of the mark on the goods, the exclusion of the marks on the same goods, the fact that the mark can be spoken, and the distinctiveness<sup>2</sup> as to particular goods. Applicant's Appeal Brief at 1. Unfortunately, the applicant did not cite any legal authority for this "test,"<sup>3</sup> nor does the applicant's test represent the standard by which the ornamentation of the mark on the goods should be determined. *See* TMEP §1203.03. Consequently, the applicant's test is not applicable to the instant case.

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<sup>2</sup> The examining attorney cannot ascertain whether the applicant is referring to the distinctiveness of the mark on the goods or the goods themselves, nor does the applicant make such a distinction.

The applicant also argues that the examining attorney's refusal is not supported by evidence or case law. Applicant's Appeal Brief at 2. The examining attorney respectfully disagrees with the applicant's unsupported statement concerning case law and notes that the applicant did not cite any case law in support of its position. Moreover, the applicant incorrectly places the burden of proof on the examining attorney. As previously stated, whether JOE COOL functions as a trademark is a fact question of which the judgment of the examining attorney is entitled to a presumption of correctness. See *In re Tilcon Warren, Inc.*, 221 USPQ 86, 88 (TTAB 1984) and cases cited therein. Accordingly, the burden of proof is on applicant to establish by competent evidence that the mark does serve a trademark function. *Id.*, at 88. Thus, the applicant's argument concerning a lack of evidence is not appropriate. Additionally, the examining attorney included evidence from a GOOGLE search that shows twenty-four thousand two hundred "hits" for the wording "JOE COOL."

The applicant argues that it did not place the mark on the goods in a small, neat, and discrete manner on the lip or rim of the goods because the applicant believed that the wording JOE COOL would not be visible to purchasers in that small space on clear plastic. The specimen of record directly contradicts the applicant's arguments. The applicant clearly has the ability to place the wording JOE COOL discretely on the goods using small neat letters as is evidenced by the wording 800 4 JOE COOL on the goods that is clearly visible. Moreover, placement of the mark on the flat rim or lip of the goods would make the mark more visible because is on the flat portion of the goods, not the portion of the goods with raised strips that protect the users hand from the hot beverage cup. Instead, the applicant made a decision to emblazon the mark using

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<sup>3</sup> The examining attorney presumes that the applicant refers to *Keene Corporation v. Paraflex industries, Inc.*, 653 F.2d 822, 211 USPQ 201 (3rd Cir. N.J. 1981)(functionality of goods). However, *Keene Corporation* does not

large decorative lettering on *both* sides of the goods to capitalize on the well known phrase JOE COOL in order to sell the goods; consumers would like to be "cool."

### CONCLUSION

The wording JOE COOL is not inherently distinctive; the wording is a well known phrase.

Moreover, the size, location, and dominance of the mark applied to the goods can only lead to

the conclusion that a consumer would perceive the mark as an ornamental feature of the goods;

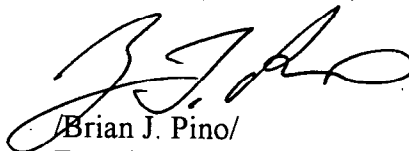
the wording appears in large, decorative, "eye catching" letters and is the dominant wording on

the goods. As a result, the applicant's specimen shows only ornamental use of the wording JOE

COOL on the goods. Consequently, the examining attorney respectfully requests that the

Trademark Trial and Appeal Board affirm the refusal.

Respectfully submitted,



/Brian J. Pino/  
Examining Attorney  
Law Office 114  
301.604.0916

Margaret Le  
Managing Attorney  
Law Office 114  
703.308.9114 Ext. 114

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support the applicant's position.